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| KLARQUIST SPARKMAN, LLP 121 SW SALMON STREET SUITE 1600 PORTLAND, OR 97204 | | | SIMS, JASON M | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------|--------------------------------|--|
| Office Action Summary | Application No. 10/801,389 | Applicant(s) CHAPLEN ET AL. | |
| | Examiner Jason M. Sims | Art Unit 1631 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-117 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-117 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-94 and 108-117 are drawn to a method of classifying a scenario by database comparison classified in class 702, subclass 19. If this group is elected, then the below summarized specie election is also required.
- II. Claim 95 is drawn to a method of analyzing data using an apparatus classified in class 702, subclass 19.
- III. Claims 96-100 are drawn to a method for detecting bioactivity of a test compound classified in class 702, subclass 19. If this group is elected, then the below summarized specie election is also required.
- IV. Claims 101-103 are drawn to a test kit for detecting bioactive compounds classified in class 702, subclass 19. If this group is elected, then the below summarized specie election is also required.
- V. Claims 104-107 are drawn to a cytosensor classified in class 702, subclass 19.

The inventions are distinct, each from the other because of the following reasons:

Inventions I, II, III, IV, and V are directed to related subject matter of classifying, detecting, and analyzing bioactivity and bioactive data. The related inventions are distinct if the inventions as claimed do not overlap in scope, i.e., are mutually exclusive; the inventions as claimed are not obvious variants; and the inventions as claimed are either not capable of use together or can have a materially different design, mode of

operation, function, or effect. See MPEP § 806.05(j). In the instant case, group I is drawn to a method of classifying a scenario. This invention involves a step of classifying a scenario by a database comparison. Group II is drawn to a method of analyzing data. The method involves applying probabilistic segmentation and parametric nonlinear auto-regressive external input models to data. Group III is drawn to a method for detecting bioactivity. The method involves placing one Betta chromatophore in functional contact with a test compound and detecting color. Group IV is drawn to a test kit for detecting bioactive compounds. This kit contains separate packaged nutrient and positive control solutions. Group V is drawn to a cytosensor. The cytosensor comprises a vessel defining an inlet for cells that provides an inlet for at least a bioactive compound and at least one test compound, a detector, and a computer.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Election of Species regarding Group I

This application contains claims directed to the following patentably distinct species for what comprises a system of the claimed invention:

A: living cells, if this group is elected, then the below summarized subspecies election is also required.

B: living organism (s)

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for groups **A-B** for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 7-27, 78, 80-82, and 108-110, for example, are generic with respect to what comprises a system.

The species are distinct as living cells may be a chromatophore or a group of cells as in a biopsy sample and a living organism or organisms are higher level organisms, such as mammals, fish, etc.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over

the prior art, the evidence or admission may be used in a rejection under 35

U.S.C. 103(a) of the other invention.

First of Two Elections of Subspecies Regarding Group I, Specie A

This application contains claims directed to the following patentably distinct subspecies of numerical feature space vector parameters for a system comprised of living cells or a living cell:

A-a) non-pigmented cells

A-b) live chromatophore (s), if this group is elected, then the below summarized subspecies election is also required.

A-c) tissue (isolated, e.g. biopsied)

A-d) a microbial community

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for groups **A-a – A-b** for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 1, for example, is generic with respect to numerical feature space vector parameters for a system comprising of living cells or a living cell.

The subspecies are distinct based on one subspecies being pigmentary cells or color producing cells, another subspecies being non-pigmented cells, a microbial community being, i.e., bacteria or fungus, and tissue being biopsied cells.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim

is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Second of Two Elections of Subspecies Regarding Group I, Specie A

This application contains claims directed to the following patentably distinct subspecies of numerical feature space vector parameters for a system comprised of living cells or a living cell:

A-1) nucleic acid composition

A-2) membrane lipid fatty acid composition

A-3) metabolic activity

A-4) cellular secretions

A-5) chemical measurements, if this group is elected, then the below summarized subspecies election is also required.

A-6) physical measurements, if this group is elected, then the below summarized subspecies election is also required.

A-7) cellular processes, if this group is elected, then the below summarized subspecies election is also required.

A-8) a specific combination selected from **A-1 – A-7**.

Applicant is reminded that particular combinations not disclosed may constitute new matter.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for groups **A-1 – A-8** for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 1, for example, is generic with respect to numerical feature space vector parameters for a system comprising of living cells or a living cell.

The subspecies are distinct because the subspecies refer to the following, nucleic acid composition (e.g., 16S-RNA profiling; DNA/mRNA microarray analysis); membrane lipid fatty acid composition (e.g., phospholipids fatty acid profiling); metabolic activity (e.g. community level physiological profiling); cellular secretions; chemical measurements (e.g. organic pollutants, nutrient discharges, heavy metals, dissolved oxygen, pH, redox, chlorine ion concentration and combinations thereof); physical measurements (temperature, ultra-violet radiation intensity, light intensity, changes in physical properties of semiconductor nanoparticles) DNA/mRNA microarray analysis);

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membrane lipid fatty acid composition (e.g., phospholipids fatty acid profiling); metabolic activity (e.g. community level physiological profiling); cellular secretions; chemical measurements (e.g. organic pollutants, nutrient discharges, heavy metals, dissolved oxygen, pH, redox, chlorine ion concentration and combinations thereof); physical measurements (temperature, ultra-violet radiation intensity, light intensity, changes in physical properties of semiconductor nanoparticles) Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Election of Subspecies Regarding Group I, subspecies A-5

This application contains claims directed to the following patentably distinct species of chemical measurements of the claimed invention: species organic pollutants, nutrient discharges, heavy metals, dissolved oxygen, pH, redox, chlorine ion concentration and any specific combination thereof.

The subspecies are distinct because of their different composition, different structure, mode of operation, or different functions.

Applicant is reminded that particular combinations not disclosed may constitute new matter.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species of chemical measurements for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 32, for example, is generic with respect to subspecies of chemical measurements.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims

are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Election of Subspecies regarding Group I, Subspecie A-6

This application contains claims directed to the following patentably distinct species of physical measurements of the claimed invention: species temperature, ultra-violet radiation intensity, light intensity, cell morphology, turbidity changes, semiconductor nanoparticles, or any specific combination thereof.

The related subspecies are distinct because they are not obvious variants, and as claimed, are either not capable of use together or have a materially different design, mode of operation, function, or effect.

Applicant is reminded that particular combinations not disclosed may constitute new matter.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species of physical measurements for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 1, for example, is generic with respect to species of physical measurements.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Election of Subspecies Regarding Group I, Subspecie A-7

This application contains claims directed to the following patentably distinct species of cellular processes of the claimed invention:

A-7-A) gene expression, if this group is elected, then the below summarized subspecie election is also required.

A-7-B) cell regulation

A-7-C) metabolism, if this group is elected, then the below summarized subspecies election is also required.

A-7-D) a specific combination thereof.

The related subspecies are distinct because they are not obvious variants, and as claimed, are either not capable of use together or have a materially different design, mode of operation, function, or effect.

Applicant is reminded that particular combinations not disclosed may constitute new matter.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species of group **A-7-A – A-7-D** for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 36, for example, is generic with respect to species of cellular processes.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Election of Subspecies Regarding Group I, Subspecie A-7-A

This application contains claims directed to the following patentably distinct species of characterizing gene expression of the claimed invention:

A-7-A-1) DNA microarray analysis

A-7-A-2) recombinant marker analysis

A-7-A-3) green fluorescent protein analysis

A-7-A-4) enzymatic activity

A-7-A-5) semiconductor nanoparticle analysis

A-7-A-6) detecting protein expression using immunodetection, if this group is elected, then the below summarized specie election is also required.

A-7-A-8) gas chromatography

A-7-A-9) liquid chromatography

A-7-A-10) mass spectrometry

A-7-A-11) nuclear magnetic resonance spectrometry

A-7-A-12) gel electrophoresis

A-7-A-13) a specific combination thereof.

The related subspecies are distinct because they are not obvious variants, and as claimed, are either not capable of use together or have a materially different design, mode of operation, function, or effect.

Applicant is reminded that particular combinations not disclosed may constitute new matter.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species of group **A-7-A-1 – A-7-A-13** for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 36, for example, is generic with respect to species of characterizing gene expression.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the

case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Election of Subspecies Regarding Group I, Subspecie A-7-A-6

This application contains claims directed to the following patentably distinct species of detecting protein expression using immunodetection of the claimed invention: species western blotting, lateral flow, immune precipitation, or a specific combination thereof.

The related subspecies are distinct because they are not obvious variants, and as claimed, are either not capable of use together or have a materially different design, mode of operation, function, or effect.

Applicant is reminded that particular combinations not disclosed may constitute new matter.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species of detecting protein expression using immunodetection for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 41, for example, is generic with respect to species of detecting protein expression using immunodetection.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim

is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Election of Subspecies Regarding Group I, Subspecie A-7-C

This application contains claims directed to the following patentably distinct species of measurements made using metabolite secretion of the claimed invention: species gas chromatography, liquid chromatography, mass spectrometry, nuclear magnetic resonance spectrometry, or a specific combination thereof.

The related subspecies are distinct because they are not obvious variants, and as claimed, are either not capable of use together or have a materially different design, mode of operation, function, or effect.

Applicant is reminded that particular combinations not disclosed may constitute new matter.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species of measurements made using metabolite secretion for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 50, for example, is generic with respect to species of measurements made using metabolite secretion.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over

the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Election of Subspecies Regarding Group I, Subspecie A-b

This application contains claims directed to the following patentably distinct species of chromatophore of the claimed invention: species fish, Betta chromatophore, frog, and Xenopus chromatophore.

The related subspecies are distinct because they are not obvious variants, and as claimed, are either not capable of use together or have a materially different design, mode of operation, function, or effect.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species of chromatophore for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 51, for example, is generic with respect to chromatophore.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims

are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Election of Species regarding Group III

This application contains claims directed to the following patentably distinct species for a test compound of the claimed invention: species bacteria, fungi, viruses, plants, animals, neurotransmitters, hormones, intracellular signal transduction agents, pharmaceutically active agents, toxic agents, agricultural chemicals, chemical toxins in ingested materials, biological toxins in ingested materials, microbes, and animal cells or a test compound that is not instantly specified.

The related species are distinct because they are not obvious variants, and as claimed, are either not capable of use together or have a materially different design, mode of operation, function, or effect.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for a test compound for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 96, for example, is generic with respect to a test compound..

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

First of Two Election of Species regarding Group IV

This application contains claims directed to the following patentably distinct species for a nutrient solution comprising a Betta chromatophore of the claimed invention: species B. splendens, B. schaumnestbauer, B. bellica, B. coccina, B. farciata, B. foerrchi, B. rmaradgina, B. maulbruter, B. anabatoidcr, B. balunga, B. brederi, B. macractoma, B. picta, B. pugrux, B. rubra, B. taenata, and B. unimaculata.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for a Betta chromatophore for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 101 and 102, for example, are generic with respect to a Betta chromatophore.

The related species are distinct because they are not obvious variants, and as claimed, are either not capable of use together or have a materially different design, mode of operation, function, or effect.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over

the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Second of Two Election of Species regarding Group IV

This application contains claims directed to the following patentably distinct species for a compound contained in a solution containing a positive control of the claimed invention: species norepinephrine, serotonin, forskolin, caffeine, adenosine, dopamine, melanocyte stimulating hormone, melanophore concentrating hormone, structural and pharmacological analogs, agonists, and antagonists.

The related species are distinct because they are not obvious variants, and as claimed, are either not capable of use together or have a materially different design, mode of operation, function, or effect.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for a compound contained in a solution containing a positive control for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 101 and 103, for example, are generic with respect to a compound contained in a solution containing a positive control.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not

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distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Sims, whose telephone number is (571)-272-7540.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Ardin Marschel can be reached via telephone 1-571-272-0718.

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the Central PTO Fax Center. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 CFR § 1.6(d)). The Central PTO Fax Center number is 1.571.273.8300.

Any inquire of a general nature or relating to the status of this application should be directed to Legal Instrument Examiner, Tina Plunkett, whose telephone number is 1.571.272.0549.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ardin H. Marschel 2/6/06
ARDIN H. MARSCHEL
SUPERVISORY PATENT EXAMINER